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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,219	04/26/2001	Shunpei Yamazaki	12732-032001 / US4867	5375
26171	7590	11/07/2005	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			HENNING, MATTHEW T	
			ART UNIT	PAPER NUMBER
			2131	

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/842,219

Applicant(s)

YAMAZAKI ET AL.

Examiner

Matthew T. Henning

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,26,51 and 54-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,26,51 and 54-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1 This action is in response to the communication filed on 8/26/2005.

2 **DETAILED ACTION**

3 *Continued Examination Under 37 CFR 1.114*

4 A request for continued examination under 37 CFR 1.114, including the fee set forth in
5 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is
6 eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)
7 has been timely paid, the finality of the previous Office action has been withdrawn pursuant to
8 37 CFR 1.114. Applicant's submission filed on 8/04/2005 has been entered.

9 *Response to Arguments*

10 Applicant appears to have filed no new arguments with the request for continued
11 examination filed 8/27/2005. Therefore, applicant's arguments filed 8/4/2005 have been fully
12 considered, but they are not persuasive.

13 Applicant argues primarily that Li did not disclose storing at least one reference
14 biological information of the client. As stated on page 10 Lines 13-15 of the communication
15 filed 8/4/2005, Li disclosed receiving a fingerprint-based token from a central authentication
16 system for comparison with the generated token. This received token is what the examiner is
17 equating as the "reference biological information". As stated in the office action dated 5/5/2005
18 in Paragraph 30, Li disclosed storing all information necessary to the operation of the Fingerprint
19 Capturing Module (FCM) in the memory unit (See Li Col. 12 Lines 20-27) and that the FCM
20 performed the comparison between the captured token (read biological information) and the
21 received reference token (reference biological information) (See Li Col. 10 Lines 57-65).
22 Therefore, the FCM needed the reference token to operate the comparison, and therefore must

1 have stored the reference token in the memory unit, at least temporarily. As such, the argument
2 is not persuasive.

3 Simply because the reference token was stored remotely does not mean that the reference
4 was not stored locally as well, as has been shown above.

5 As such, the examiner has maintained the prior art rejections presented in the office
6 action dated 5/5/2005.

7 Claims 1, 26, 51, and 54-82 have been examined. Claims 2-25, 27-50, and 52-53 have
8 been cancelled.

9 All objections and rejections not set forth below have been withdrawn.

10 *Specification*

11 Applicant is reminded of the proper language and format for an abstract of the disclosure.

12
13 *The abstract should be in narrative form and generally limited to a single paragraph on*
14 *a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed*
15 *150 words in length since the space provided for the abstract on the computer tape used by the*
16 *printer is limited. The form and legal phraseology often used in patent claims, such as "means"*
17 *and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist*
18 *readers in deciding whether there is a need for consulting the full patent text for details.*

19
20 *The language should be clear and concise and should not repeat information given in the*
21 *title. It should avoid using phrases which can be implied, such as, "The disclosure concerns,"*
22 *"The disclosure defined by this invention," "The disclosure describes," etc.*

23
24 The abstract as amended is objected to because it less than 50 words and therefore does
25 not meet the length requirement for the Abstract of the Disclosure. The examiner has counted 44
26 words not including non-descriptive words such as 'a', 'of', 'and', 'the', etc.

27 Appropriate correction is required. See MPEP § 608.01(f).

28 *Claim Rejections - 35 USC § 102*

1 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
2 basis for the rejections under this section made in this Office action:

3 *A person shall be entitled to a patent unless –*

4 *(e) the invention was described in (1) an application for patent, published under section*
5 *122(b), by another filed in the United States before the invention by the applicant for patent or*
6 *(2) a patent granted on an application for patent by another filed in the United States before the*
7 *invention by the applicant for patent, except that an international application filed under the*
8 *treaty defined in section 351(a) shall have the effects for purposes of this subsection of an*
9 *application filed in the United States only if the international application designated the United*
10 *States and was published under Article 21(2) of such treaty in the English language.*
11

12 Claims 1, 26, 51, 54-60, and 62-82 are rejected under 35 U.S.C. 102(e) as being
13 anticipated by Li et al. (US Patent Number 6,219,793) hereinafter referred to as Li.

14 Regarding claims 1 and 26, Li disclosed a portable communication device having a
15 system for identifying an individual to identify a client (See Li Abstract), said portable
16 communication device comprising: a memory for storing at least one reference biological
17 information of the client (See Li Fig. 4 Element 404, Col. 10 Lines 57-65 and Col. 12 Lines 20-
18 27); a sensor for reading at least one biological information of the client (See Li Fig. 4 Element
19 417); a checking circuit for checking the read biological information with the stored biological
20 information (See Li Fig. 4 Element 401 and Col. 12 Lines 8-36); a transmitting circuit for
21 transmitting information that the read biological information and the stored biological
22 information have matched to a server in a case where the checking has matched (See Li Fig. 4
23 Elements 402 and 102 and Col. 11 Lines 3-9).

24 Regarding claim 51, Li disclosed a business method using the Internet, said business
25 method comprising: identifying a client by an identifying element loaded in a portable
26 communication device (See Li Fig. 1 Elements 101, 102, and 112 and Fig. 4); and controlling a

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1 communication between the client and a plurality of dealers (See Li Fig. 2 Element 202) by a
2 control element in a server (See Li Abstract, and Figs. 3A and 3B); wherein said identifying
3 comprises: storing a reference biological information of the client in the portable communication
4 device (See Li Fig. 4 Element 404 and Col. 10 Lines 57-65 and Col. 12 Lines 20-27); reading
5 biological information of the client (See Li. Col. 10 Lines 57-58); checking the read biological
6 information with the reference biological information (See Li Col. 10 Lines 61-65) ; and
7 transmitting information that the read biological information and the reference biological
8 information have matched from the identifying element to the control element in a case where
9 the checking has matched (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines 3-9), and
10 wherein said controlling step comprises: admitting the communication between the client and the
11 plurality of dealers after identifying the client by the identifying element (See Li Col. 11 Lines
12 19-60); and providing a password to the client (See Li Col. 10 Lines 48-56).

13 Regarding claims 54 and 66, Li disclosed that the memory stores a plurality of biological
14 information of the client (See Li Col. 15 Paragraph 3 and Col. 3 Paragraph 3 and Col. 10
15 Paragraph 4), and the transmitting circuit transmits information that the read biological
16 information has matched with at least one of the stored plurality of information to the server (See
17 Li Col. 11 Lines 3-9).

18 Regarding claims 55 and 67, Li disclosed that the sensor reads a plurality of biological
19 information of the client (See Li Col. 15 Paragraph 4), and the transmitting circuit transmits
20 information that each of the plurality of read biological information has matched with at least
21 one of the plurality of stored biological information (See Li Col. 11 Lines 3-9).

1 Regarding claims 56 and 68, Li disclosed that the information that the read biological
2 information and the stored biological information have matched is transmitted to the server
3 through the Internet (See Li Col. 7 Paragraph 2).

4 Regarding claims 57 and 71, Li disclosed that after transmitting information that the
5 checking has matched to the server, a personal identification number information is sent to the
6 Server (See Li Col. 15 Paragraphs 3-4).

7 Regarding claims 58 and 72, Li disclosed that in a case that the personal identification
8 number matches with a number stored at the server, the stored biological information is
9 rewritable (See Li Col. 15 Paragraph 3).

10 Regarding claims 59-60, 73-74, and 78-79, Li disclosed that the biological information is
11 one selected from the group consisting of a fingerprint, a palm pattern and a voice print; and that
12 the palm pattern is a whole pattern of the palm or a pattern of a part of the palm (See Li Col. 6
13 Paragraph 3 and Col. 17 Paragraph 3).

14 Regarding claim 62, Li disclosed that the sensor includes one of a photodiode and a CCD
15 (See Li Col. 4 Paragraph 6).

16 Regarding claims 63-65, 75-77, and 80-82, Li disclosed that the portable communication
17 device comprises a portable information terminal; a portable telephone; a personal computer (See
18 Li Col. 5 Line 66 – Col. 6 Line 14).

19 Regarding claims 69-70, Li disclosed a step of transmitting information that the checking
20 has matched from the server to a connection of the client; and that a transaction is started
21 between the client and the connection after the connection has received information that the
22 checking has matched (See Li Col. 16 Paragraph 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li as applied to claim 1 above, and further in view of Osborn (US Patent Number 6,026,293).

Li disclosed a memory unit containing programs, responses and any other information the Fingerprint Capturing Module of the cellular phone needed to operate (See Li Col. 12 Lines 20-27), but failed to disclose what type of memory the memory unit was.

Osborn teaches that in cellular telephones, programs are stored in flash memory (See Osborn Col. 3 Line 61 – Col. 4 Line 2).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Osborn in the authenticating cellular telephone of Li by providing the memory unit as a flash memory. This would have been obvious because the ordinary person skilled in the art would have been motivated to store the programs of the phone in the conventional manner.

Conclusion

Claims 1, 26, 51, and 54-82 have been rejected.

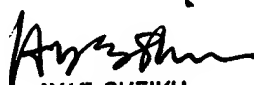
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790. The examiner can normally be reached on M-F 8-4.

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1 If attempts to reach the examiner by telephone are unsuccessful, the examiner's
2 supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the
3 organization where this application or proceeding is assigned is 571-273-8300.

4 Information regarding the status of an application may be obtained from the Patent
5 Application Information Retrieval (PAIR) system. Status information for published applications
6 may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
7 applications is available through Private PAIR only. For more information about the PAIR
8 system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR
9 system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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16 Matthew Henning
17 Assistant Examiner
18 Art Unit 2131
19 11/1/2005


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